

REMARKS

Claims 1-73 are pending, with claims 1, 19, 23 and 26 being independent. Claim 1 has been amended. No new matter has been added. Reconsideration and allowance of the above-referenced application are respectfully requested.

Rejections under 35 U.S.C. 101

Claims 1-18 stand rejected under 35 U.S.C. 101. The Office asserts that the claimed receiving, specifying and detecting can "be reasonably interpreted as a series of steps completely performed mentally, verbally or without a machine."¹ However, claim 1 specifically states that the method is a "computer-implemented" method. Nonetheless, in order to expedite prosecution, and without conceding the propriety of the rejection, independent claim 1 has been amended to state in the body of the claim that, "the receiving, the specifying and the detecting are performed by data processing apparatus." Thus, claims 1-18 are clearly tied to another statutory class (i.e., a particular apparatus), and withdrawal of the rejection under 35 U.S.C. 101 is respectfully requested.

Rejections under 35 U.S.C. 103

Claims 1-10, 12-35, 37-51, 53-66, and 68-73 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over U.S. Patent No. 6,239,792 to Yanagisawa et al. (hereinafter "Yanagisawa"). Claims 11, 36, 52, and 67 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over Yanagisawa as applied to claim 1, and further in view of US Pat.

¹ See 01-23-2009 Office Action at page 3.

No. 7,006,711 to Dresevic et al. (hereinafter "Dresevic"). These contentions are respectfully traversed.

Independent claim 1 recites, "receiving input specifying a path including a plurality of locations ordered along the path; for each location in the plurality of locations, specifying a tracking zone based on the location and a previous location preceding the location along the path, the tracking zone indicating a direction of the path at the location; and detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone["]."² In rejecting this claimed subject matter, the Office has improperly parsed the features of the claims into sub-components, thereby ignoring the context and meaning of the claim, as a whole. The Office asserts that Yanagisawa discloses specifying a tracking zone, but not a tracking zone that that indicates a direction of the path at the location, and the Offices asserts that Yanagisawa discloses detecting a motion between a first and a second location in the path, but not detecting a backward motion.³

The Office thus acknowledges that Yanagisawa fails to teach the claimed subject matter, but also asserts that Yanagisawa teaches some of the claimed subject matter by improperly detaching language from various elements of the claim. The Office then attempts to address the identified deficiencies of Yanagisawa by stating:

It would have been obvious to one of ordinary skill in the art to include indicating a direction and detecting a backward motion with the method of Yanagisawa

² Emphasis added.

³ See 01-23-2009 Office Action at page 4.

because Yanagisawa teaches the input indicating erasure and the pen operating like an eraser, which moves in a back and/or a forth direction to delete points.⁴

First, as a matter of law, the Office's detaching of language from various claim elements is improper because, as MPEP § 2141.02(I) makes clear, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious" (emphasis added) (internal citations omitted). Second, operating a pen like an eraser, which moves in a back and/or a forth direction to delete points, as described in Yanagisawa, has nothing to do with detecting a backward motion as claimed.

Yanagisawa describes a technique for controlling the erasure area associated with a trace when erasing previously drawn points, lines, characters or images made up of such.⁵ In the erasure mode, input points are received (through the pen) defining a trace and a corresponding erasure area along the trace, where the size of the erasure area is governed by the speed of the pen (i.e., the distance between the input points of the trace).⁶ However, that which is erased is the previously drawn points, lines, characters or images on the LCD screen. The input points of the trace are not themselves erased, but rather specify points, and an associated erasure area, on the LCD screen at which information is to be erased. Of course, the user can make backward motions on the screen, but Yanagisawa does not detect backward motions, as such; he just erases the data on the screen in response to them, as done in response to any other motion of the pen across the screen when in the erasure mode. Thus, Yanagisawa has no teaching of, nor a need

⁴ See 01-23-2009 Office Action at pages 4-5.

⁵ See Yanagisawa et al. at col. 4, lines 11-20.

⁶ See Yanagisawa et al. at col. 4, lines 21-41, and col. 6, lines 57-62.

for, a process of detecting backward motion among the input points of the trace, and claim 1 cannot be considered as reading the disclosure of Yanagisawa.

In addition, in support of the current attempt to expand the teachings of Yanagisawa, the Office states:

One of ordinary skill in the art would have been motivated to include indicating a direction and detecting a backward motion with the method of Yanagisawa for the benefit of improving specification of points for deletion.⁷

The Office has provide no explanation of how such modifications of Yanagisawa would improve specification of points for deletion. Thus, the current rejection under 35 U.S.C. 103(a) fails the applicable legal standard, as articulated by the Supreme Court in *KSR Int'l Co. v. Teleflex*, where the Court made clear that "rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of the obviousness."⁸

Furthermore, the Office has failed to address how Yanagisawa can be considered to teach the use of overlapping tracking zones as respectively required in each of independent claims 1, 19, 23 and 26. Rather, the Office merely states:

Thus, during erasure mode the motion of the pen over consecutive input points, which were previously input to define a trace, is tracked to identify areas surrounding the consecutive input points. The identified areas are erased from the screen (col. 5, ll. 2-5). Hence, movement of the pen, which is like an eraser during erasure mode, from one input point to an input point one sampling point

⁷ See 01-23-2009 Office Action at page 5.

⁸ See *KSR Int'l Co. v. Teleflex*, 127 S.Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)) (emphasis added); MPEP § 2141(III).

before (col. 4, ll. 35-40) suggests a backward motion along the original trace as erasing occurs due to a back and/or forth motion. Therefore, Yanagisawa et al. teach "detecting a backward motion between a first and a second location in the path if the first location's tracking zone overlaps with the second location's tracking zone."⁹

Thus, the Office has contradicted its own earlier statement that Yanagisawa does not detect a backward motion.¹⁰ Moreover, these conclusory statements do not indicate in any way how Yanagisawa can be considered to teach the use of overlapping tracking zones (regardless of whether or not a motion is a backward motion) as respectively required in each of independent claims 1, 19, 23 and 26.

Arguments were presented regarding this issue in the Pre-Appeal Brief filed on 9-23-2008, and the Office has failed to address these arguments. In particular, the insufficiency of the conclusion in the Advisory Action dated 8-25-2008 ("Thus, Yanagisawa's coupling of an enlarged erasure area of an input point with a neighboring input point erasure area suggests overlap of tracking zones as the contact between neighboring erasure areas indicates the effect of deletion at that point.") was addressed. As previously noted, coupling of erasure areas cannot be reasonably equated with an overlap of two tracking zones, as claimed.

Even if the erasure areas of Yanagisawa do overlap in some cases, which is not conceded, this does not teach the claimed subject matter. The larger erasure area is still defined by the union of the two erasure areas and the area there between. There is nothing in Yanagisawa, or the current rejections that requires identification of overlap of the erasure areas as a pre-condition

⁹ See 01-23-2009 Office Action at pages 14-15.

¹⁰ See 01-23-2009 Office Action at page 4.

for detecting motion, as is required by each of the present claims. Rather, all Yanagisawa is describing is the creation of a larger erasure area based on the speed of the pen, and once this larger erasure area is known, all the pixels on the screen within that area are erased. This does not in any way teach or suggest backward motion detection as respectively claimed in each of independent claims 1, 19, 23 and 26.

Furthermore, attention is called to the duties of the Office, and in particular to the following: "The examiner should never lose sight of the fact that in every case the applicant is entitled to a full and fair hearing, and that a clear issue between applicant and examiner should be developed, if possible, before appeal."¹¹ Based on the current rejections, the Office's position with respect to how the claims can be considered to read on the art is not understood, and the undersigned attorney would appreciate clarification of the Office's position before having to appeal this case yet again.

For the above reasons, each of independent claims 1, 19, 23 and 26 should be in condition for allowance. Since Dresevic fails to cure the noted deficiency of Yanagisawa, each of dependent claims 11, 36, 52, and 67, as well as each of dependent claims 2-10, 12-18, 20-22, 24, 25, 27-35, 37-51, 53-66 and 68-73 should be patentable based on their respective base claims and the additional recitations they contain.

For example, each of claims 6, 31, 48 and 63 require specification of "a tracking zone that is inside the influence region of the location and outside the influence region of the previous location." The cited portions of Yanagisawa (col. 4, lines 10-26, and col. 6, lines 5-25) describe the use of an erasure area or a drawing area (depending on the selected mode) having a specified

¹¹ See MPEP 706.07.

shape, such as a circle, “square, ellipsoid, rhombus, and the like.” Nothing in Yanagisawa describes specifying a tracking zone that is inside the influence region of the location and outside the influence region of the previous location, as respectively recited in claims 6, 31, 48 and 63. In response, the Office states, “When erasing fine and narrow information, such as a single point, the erasure area only affect[s] the single point and is within the influence region, the erasure area affecting that point, and outside the influence region of another point.”¹² Thus, the Office is attempting to equate the erasure area of an input point in Yanagisawa with both the claimed influence region and the claimed tracking zone. This claim construction defies common sense, is inconsistent with the present specification,¹³ and is improper as a matter of law since it renders a portion of the claim language superfluous.¹⁴ Thus, for at least the above reasons, the rejection of claims 6, 31, 48 and 63 should be withdrawn, and these claims should be allowed.

As another example, claims 7 and 32 each recite, “deleting a portion of the path if a backward motion is detected between the first and second locations, the deleted portion of the path connecting the first location to the second location and including one or more locations in the plurality of locations in the path.” The cited portions of Yanagisawa (col. 2, lines 38-40, and col. 4, lines 27-32) and the rest of Yanagisawa describes erasing information in the area along the trace of the pen, not deleting a portion of the input points defining the trace. Thus, these claims cannot be considered as reading on Yanagisawa for at least this reason. Therefore, the rejection of claims 7 and 32 should be withdrawn, and these claims should be allowed.

¹² See 01-23-2009 Office Action at page 15.

¹³ See e.g., the present application's description of FIGs. 2A-2F.

¹⁴ See *Pickholtz v. Rainbow Techs., Inc.*, 284 F.3d 1365, 1373 (Fed. Cir. 2002), citing *Elekta Instrument S.A. v. O.U.R. Scientific International, Inc.* 214 F.3d 1302, 1307 (Fed. Cir. 2000.)

The claims that depend from claims 7 and 32 should be allowable based on the above reasoning and the additional recitations they contain. For example, claims 15 and 40 recite, “defining a new portion of the path, the new portion replacing the deleted portion.” The cited portion of Yanagisawa (col. 6, lines 5-20) and the rest of Yanagisawa describes alternatively drawing or erasing image information on the screen based on the selected mode, not deleting a portion of the trace and defining a new portion of the trace to replace the deleted portion. Thus, the rejection of claims 15 and 40 should be withdrawn, and these claims should be allowed.

Conclusion

The foregoing comments made with respect to the positions taken by the Office are not to be construed as acquiescence with other positions of the Office that have not been explicitly contested. Accordingly, the above arguments for patentability of a claim should not be construed as implying that there are not other valid reasons for patentability of that claim or other claims.

A formal notice of allowance is respectfully requested. In the absence of such, a telephone interview with the Examiner and the Examiner's supervisor is respectfully requested to discuss claims 1, 6, 7 and 15 of the present application in light of the rejections of record.

Applicant : Sambit Dash
Serial No. : 10/633,436
Filed : July 31, 2003
Page : 21 of 21

Attorney's Docket No.: 07844-0601001 / P554

No fees are believed due with this response. Nonetheless, please apply any necessary charges or credits, to deposit account 06-1050.

Respectfully submitted,

Date: _____

April 9, 2009

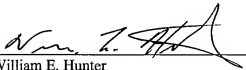
Fish & Richardson P.C.

PTO Customer No. 21876

Telephone: (858) 678-5070

Facsimile: (877) 769-7945

10900297.doc



William E. Hunter
Reg. No. 47,671